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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,351	07/17/2003	Masaki Katoh	R2184.0097/P097-B	8926
24998	7590	04/06/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			PATEL, GAUTAM	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	

2655

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,351

Applicant(s)

KATOH ET AL.

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2655

Response to Amendment

1. This is in response to amendment filed on 12-1-04.
2. Claims 10-20 remain for examination. Claims 19-20 are newly presented for examination.

Double Patenting

PROVISIONAL REJECTION, 35 U.S.C. 101, DOUBLE PATENTING

3. Claims 1-9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 10 of copending application Serial No. 09/793,131. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 1-9 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-31 of copending application which is in process of becoming a U.S. Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other because removing relationship of the addresses and removing arbitrary address tx does not change the scope of the claim 1 as presented and it does not require presence of these limitations.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

As to claim 20, since it is also fully disclosed in the application 09/793,131 which in process of becoming a patent; it is therefore considered rejected also as non-statutory double patenting as set forth in the paragraphs here in above.

Claim Rejections - 35 U.S.C. § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-11, 13-16, 18 and 19-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Akihiro, JAP. publication 08-185631.

As to claim 10, Akihiro discloses the invention as claimed [see Figs. 1-9, especially 1-2] an optical pickup including a detection part and a correction part, comprising:

a detection part detecting [fig. 1, units 3 & 4] as to whether or not the inconsecutive portion of addresses occurs in the optical information recording medium based on a signal detected via said optical pickup [para. 20-22]; and

a correction part correcting address [fig. 1, units 3-4 and 6] in the inconsecutive portion in case the inconsecutive portion is detected by said detection part [para. 20-22].

5. The aforementioned claim 11, recites the following elements, inter alia, disclosed in Akihiro:

said correction part performs the address correction by skipping addresses [track jump] for the inconsecutive portion [para. 18-22].

6. The aforementioned claim 13, recites the following elements, inter alia, disclosed in Akihiro:

in case said detection part determines that the address inconsecutive portion occurs, said correction part performs address correction in use of address information concerning the inconsecutive portion which is previously obtained [para. 23-27].

7. The aforementioned claim 14, recites the following elements, inter alia, disclosed in Akihiro:

Art Unit: 2655

a read signal processing part [fig. 1, unit 3] performing extraction of an address signal from a signal read via the optical pickup;

an address demodulation part [fig. 1, unit 3, decoding is done by this unit] performs demodulation of the address signal obtained from said read signal processing part;

a detection part detecting [fig. 1, units 3 & 4] as to whether or not an inconsecutive portion of addresses occurs in the optical information recording medium based on an output of said address demodulation part; and

a correction unit [fig. 1, units 3 & 4] correcting address in the inconsecutive portion in case the inconsecutive portion is detected by said detection part [para.18-22].

8. As to claims 15-16 and 18, they are method claims corresponding to claims 10-11 and 13 respectively and they are therefore rejected for the same reasons set forth in the rejection of claims 10-11 and 13 respectively, supra.

9. The aforementioned new claim 19, recites the following elements, inter alia, disclosed in Akihiro:

a signal processing part [fig. 1, unit 3] performing extraction of an ATIP signal from a signal read via the optical pickup and demodulation of the ATIP signal para. 22-23];

a detection part detecting [fig. 1, units 3 & 4] as to whether or not the inconsecutive portion of addresses exist in the optical information recording medium [para. 20-22]; and

a correction part setting a start address on a portion ahead of the inconsecutive portion of addresses when existence of the inconsecutive portion of addresses is detected by said detection part; and [para. 20-22]; and

wherein said detection part detects as to whether or not an inconsecutive portion of addresses occurs in the optical information recording medium on which data will be recorded based on ATIP information concerning the inconsecutive portion of addresses and an output of the signal processing part, said ATIP information being previously recognized by the apparatus [para. 20-24].

Art Unit: 2655

10. The aforementioned new claim 20, recites the following elements, inter alia, disclosed in Akihiro:

the correction part sets $t1 - (t2' - t1')$ as said start address, wherein $t1$ is an address set as a start address for an optical information recording medium having no inconsecutive portion of addresses and the inconsecutive portion of addresses is set between an address $t1'$ through and address $t2'$, and $t1' < t2'$ [para. 20-24 and fig. 2(C)].

NOTE: address A < address B. See page 11 para. 23.

Claim Rejections - 35 U.S.C. § 103

11. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 12 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Akihiro as applied to claims 10-11, 13-16 and 18 above in view of Usui et al., US. patent 6,160,779 (hereafter Usui).

As to claim 12, Akihiro discloses all of the above elements, including detecting and correcting inconsecutive portion of the addresses. Akihiro does not specifically disclose that address correction performed in a time of trial writing processing for setting a power of light which is emitted from said optical pickup at a time of recording information.

However, ALPC is well known in the art. Also, Usui clearly discloses adjusting power during calibration and addresses are adjusted during this process by laser power controller 118 [col. 6, line 48 to col. 7, line 25].

Both Akihiro and Usui are interested in improving the recording mechanism and data layout in an optical disk device. Both show address arrangement.

One of ordinary skill in the art at the time of invention would have realized reliability of the data recording is good feature to have for higher system performance.

Art Unit: 2655

Therefore, it would have been obvious to have used address correction performed during trail write for setting power in the system of Akihiro as taught by Usui because one would be motivated to increase reliability of data recording at proper address [ID] [col. 4, lines 16-29].

13. As to claims 17, it is a method claims corresponding to claim 12 and it is therefore rejected for the same reasons set forth in the rejection of claim 12, supra.

14. Applicant's arguments filed on 12-1-04 have been fully considered but they are not deemed to be persuasive for the following reasons.

15. In the REMARKS, the Applicant argues as follows:

A) That: "claim 10, as amended, has a detection part detecting as to whether or not "the [original emphasis] inconsecutive portion occurs in the ... medium." Akihiro refers to a system in which continuity of an address is lost due to focus error or mechanical shock. Akihiro fails to disclose or suggest the detection part of claim 10, as amended." [page 6, para. 3; REMARKS].

FIRST: Akihiro clearly discloses the system controller 4, which monitors continuity of addresses [page 10, para. 21 line 2-3]. In other words unit 4 detects continuity or lack thereof.

SECOND: It is not clear to the Examiner why argument regarding focus error or mechanical shock has been presented since these aspects are neither claimed nor does the Examiner refers to them.

16. **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a).

Applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2655

Contact information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is 703-872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (571) 272-7629.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.

Gautam R. Patel
Primary Examiner
Group Art Unit 2655


**GAUTAM R. PATEL
PRIMARY EXAMINER**

March 30, 2005